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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/817,300	03/27/2001	Masanori Kawashima	35.C15221	7780
5514	7590	02/27/2006		
FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			EXAMINER EL CHANTI, HUSSEIN A	
			ART UNIT 2157	PAPER NUMBER

DATE MAILED: 02/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/817,300

Applicant(s)

KAWASHIMA, MASANORI

Examiner

Hussein A. El-chanti

Art Unit

2157

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 November 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-46 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-46 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to RCE received on Nov. 30, 2005. Claims 47-52 were canceled. Claims 1-46 are pending examination.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1, 11, 21, 26, 31, 35, 39 and 43 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.
3. Claims 1, 11, 21, 26, 31, 35, 39 and 43 state "not to display the type of the device information not designated by the user in said first designating step in the device list" and "wherein said display control step is adapted to control to display in the device list the type of device information designated by the user in said second designating step even in a case where the type of device information designated by the user in said second designating step is not designated by the user in said first designating step".

Any negative limitation or exclusionary proviso must have basis in the original disclosure. If alternative elements are positively recited in the specification, they may be explicitly excluded in the claims. See *In re Johnson*, 558 F.2d 1008, 1019, 194 USPQ 187, 196 (CCPA 1977) ("[the] specification, having described the whole, necessarily

described the part remaining.”). See also *Ex parte Grasselli*, 231 USPQ 393 (Bd. App. 1983), *aff’d mem.*, 738 F.2d 453 (Fed. Cir. 1984). The mere absence of a positive recitation is not basis for an exclusion. Any claim containing a negative limitation which does not have basis in the original disclosure should be rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. Note that a lack of literal basis in the specification for a negative limitation may not be sufficient to establish a *prima facie* case for lack of descriptive support. *Ex parte Parks*, 30 USPQ2d 1234, 1236 (Bd. Pat. App. & Inter. 1993).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-46 are rejected under 35 U.S.C. 102(e) as being anticipated by Carcerano et al., U.S. Patent No. 6,308,205 (referred to hereafter as Carcerano).

Carcerano teaches the invention explicitly as claimed including a system and method for using a browser to change the status and configuration of the device (see abstract).

As to claims 1, 11, 21, 26, 31, 35, 39 and 43, Carcerano teaches a network-managing method, device, program and medium for providing a device list with which

device information with regard to a plurality of devices is arranged in order and displayed for every device, comprising:

- a first designating step of accepting a user designation of a type of a device information specified to be displayed in the device list (see col. 12 lines 6-42);

- a display control step of controlling to display, from among the plurality of types of device information, the type of the device information designated by the user in said first designating step in the device list, and not to display the type of the device information not designated by the user in said first designating step in the device list (see col. 12 lines 61-col. 13 lines 13, user can view/change or update device configuration using the browser); and

- a second designating step of accepting a user designation of a type of the device information used to be criterion in the case where a plurality of devices are arranged in order in the device list (see col. 12 lines 61-col. 13 lines 13, system displays the device with properties where user can modify and update device configuration such as device status); and

wherein said display control step is adapted to control to display in the device list the type of device information designated by the user in said second designating step even in a case where the type of device information designated by the user in said second designating step is not designated by the user in said first designating step (see col. 14 lines 46-67 and col. 15 lines 22-col. 16 lines 4, the updates are recorded in the database and displayed to the user upon user request).

As to claims 2, 12, 22, 27, 32, 36, 40 and 44, Carcerano teaches the method, device, program and medium according to claims 1, 11, 21, 26, 31, 35, 39 and 43 respectively, further comprising a display step of displaying the device list on a display area (see col. 12 lines 5-col. 13 lines 67).

As to claims 3, 13, 23, 28, 33, 37, 41 and 45, Carcerano teaches the method, device, program and medium according to claims 1, 11, 21, 26, 31, 35, 39 and 43 respectively, further comprising a sort step that a plurality of devices is sorted based on device information of a type obtained in the second obtaining step, wherein in the control step, a device information of a type obtained in the first obtaining step and a device information of a type obtained in the second acquisition step are controlled to be displayed in order of sorted device in the device list (see col. 12 lines 5-col. 13 lines 67).

As to claims 4, 14, 24, 29, 34, 38, 42 and 46, Carcerano teaches the method, device, program and medium according to claims 1, 11, 21, 26, 31, 35, 39 and 43 respectively, wherein said first step has a type information obtaining step of obtaining a type information representing a type of a device information specified to be displayed in the device list, and said control step has a changing step of changing the type information so that the device information of a type obtained in the second obtaining step is displayed in the device list (see col. 12 lines 61-col. 13 lines 30).

As to claims 5, 15, 25 and 30, Carcerano teaches the method, device, program and medium according to claims 1, 15, 25 and 30 respectively, comprising:

a detection step of detecting a plurality of devices connected to a network; a device information obtaining step of obtaining a device information from a detected a

plurality of devices; and a device list generation step of generating a device list data representing the device list based on a obtained device information (see col. 12 lines 5-col. 13 lines 67).

As to claims 6 and 16, Carcerano teaches the method according to claims 5 and 15, comprising a storing step of storing obtained device information in a memory area, and, in the device list generation step, generating the device list data based on a device information stored in the memory area (see col. 15 lines 22-col. 16 lines 4).

As to claims 7 and 17, Carcerano teaches the method according to claims 5 and 15, comprising: a transmitting step of transmitting a generated device list data to a network; and a display controlling step of analyzing the transmitted device list data and having a display area display the device list (see col. 12 lines 5-col. 13 lines 67).

As to claims 8 and 18, Carcerano teaches the method according to claims 7 and 17, wherein said device list data is data described in HTML, and in the device list transmitting step the device list data being transmitted to a network using an HTTP protocol (see col. 12 lines 61-col. 13 lines 30).

As to claims 9 and 19, Carcerano teaches the method according to claims 8 and 18, wherein the device is a printer (see col. 1 lines 15-55).

As to claims 10 and 20, Carcerano teaches the method according to claims 1 and 11, wherein the device information is at least one selected from the group of device name, device product name, location of device installation, device network address and device MAC address (see col. 12 lines 5-col. 13 lines 67).

Response to Arguments

5. Applicant's arguments have been fully considered but are moot in view of the new grounds of rejection.

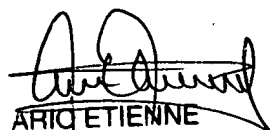
6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hussein A. El-chanti whose telephone number is (571)272-3999. The examiner can normally be reached on Mon-Fri 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on (571)272-4001. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Hussein El-chanti

Feb. 7, 2006


ARIO ETIENNE
PRIMARY EXAMINER